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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/992,036	11/23/2001	Michael D. Dahlin	1039-0040	4450
34456 7590 01/06/2009 LARSON NEWMAN ABEL & POLANSKY, LLP 5914 WEST COURTYARD DRIVE SUITE 200 AUSTIN, TX 78730				
EXAMINER				
PASS, NATALIE				
ART UNIT		PAPER NUMBER		
3686				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

## Application No.

09/92,036

## Applicant(s)

DAHLLIN ET AL.

## Examiner

Natalie A. Pass

## Art Unit

3686

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 14 October 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 9-11, 16-20, 25-31, 40-44 and 51-53 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 9-11, 16-20, 25-31, 40-44 and 51-53 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/3508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

## **DETAILED ACTION**

### ***Notice to Applicant***

1. This communication is in response to the amendment filed 14 October 2008. Claims 9, 18, and 52 have been amended. Claims 1-8, 12-15, 21-24, 32-39, and 45-50 have been cancelled. Grounds of rejection for claims 9-11, 16-20, 25-31, 40-44 and 51-53 are set forth in detail below.

### ***Claim Rejections - 35 USC § 112***

2. The rejection of claims 39 and 53 under 35 U.S.C. § 112, first paragraph, for reciting new matter is hereby withdrawn due to the amendment filed 14 October 2008.

3. The rejections of claims 39 and 52 under 35 U.S.C. § 112, second paragraph are hereby withdrawn due to the amendment filed 14 October 2008.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 9-11, 16-20, 25-31, 40-44, and 51-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lewis et al., U.S. Patent Application Publication No. 2001/0041992 (it should be noted that the Examiner is relying on the priority date from the Lewis parent application 09/523,569; based on review of the parent application it is believed that the portions of the child application cited below are fully supported by the parent application), and Yoder, J. et al., The MEDIGATE Graphical User Interface for Entry of Physical Findings: Design Principles and Implementation. Journal of Medical Systems. Vol. 22, No. 5 / October, 1998, pages 325-337. URL: <<http://www.springerlink.com/content/g8504238744271h2/fulltext.pdf>>, hereinafter known as Medigate, for substantially the same reasons given in the previous Office Action (paper number 20080408). Further reasons appear hereinbelow.

(A) Claim 9 has been amended to recite:

- “wherein the first set of controls includes a tri-state control configured to indicate present, not present, or not entered, the method further comprising: accepting from the user an indication of not present, the indication resulting from the user selecting the tri-state control twice; and storing data associating the indication with the first selection,” in lines 16-20.

As per these new limitations, Lewis and Medigate teach a method as analyzed and discussed in the previous Office Action (paper number 20080408) further comprising

wherein the first set of controls includes a tri-state control configured to indicate present, not present, or not entered (Medigate; page 330, paragraph 2), the method further comprising:

accepting from the user an indication of “Normal” (reads on “not present”), the indication resulting from the user selecting the tri-state control twice (Medigate; page 330, paragraph 2, paragraph bridging pages 331-332); and

storing data associating the indication with the first selection (Medigate; paragraph bridging pages 331-332).

The remainder of claim 9 is rejected for the same reasons given in the prior Office Action (paper number 20080408, section 9, pages 5-12), and incorporated herein.

The motivations to combine the respective teachings of Lewis and Medigate are as discussed in claim 9 of the previous Office Action (paper number 20080408), and incorporated herein.

(B) Amended claim 18 recites substantially similar apparatus limitations to amended method claim 9 and, as such, is rejected for similar reasons as given above.

(C) As per the amendments to claim 52, these appear to have been made merely to correct errors in the claim language, and to overcome rejections under 35 USC § 112. While these changes render the language of the claim smoother and more consistent, they otherwise affect neither the scope and breadth of the claim as originally presented nor the manner in which

the claim was interpreted by the Examiner when applying prior art within the previous Office Action.

As such, the recited claimed features are rejected for the same reasons given in the prior Office Action (paper number 20080408, section 9, pages 5-12), and incorporated herein.

(D) Claims 10-11, 16-17, 19-20, 25-31, 40-44, 51, and 53 have not been amended and are rejected for the same reasons given in the previous Office Action (paper number 20080408, section 9, pages 5-12), and incorporated herein.

### ***Response to Arguments***

6. Applicant's arguments filed 14 October 2008 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response filed 14 October 2008.

(A) As per Applicant's arguments on pages 7-8 of the response filed 14 October 2008 regarding the rejections of claims 39 and 53 under 35 U.S.C. § 112, first paragraph and the rejections of claims 39 and 52 under 35 U.S.C. § 112, second paragraph, these arguments were persuasive, and accordingly the rejections have been withdrawn.

(B) As per Applicant's arguments in paragraph 2 on page 9 of the response filed 14 October 2008 that "the filing date of Lewis postdates the priority date of the present application" and that "the priority document of Lewis ... [...] ... is lacking much of the disclosure of Lewis

... [and] ... fails to teach or suggest many elements recited in the claims,” Examiner respectfully disagrees. Firstly, Examiner notes that Applicant fails to specify precisely what features or “elements recited in the claims” are missing in the priority document of Lewis. Secondly, as per arguments relating to discrepancies between the applied Lewis reference and the parent application of the Lewis reference (09/523,569), Examiner notes that although the diagrams are not labeled identically to the applied Pre-Grant Publication, and although the diagrams are not identical, nevertheless Examiner interprets the subject matter, to teach Applicants limitations. For example, numerous figures, such as Figures 4A-4E of the parent application of Lewis show examples of a graphical interface which simultaneously displays a graphical representation of anatomical features (401 , 410) and a set of controls (404, 412) relating to the plurality of medical conditions. In addition, descriptive text further elucidates the Lewis parent application (for example, see the Lewis parent application: page 4, lines 11-21, page 7, lines 24-30, page 15, lines 11-32, paragraph bridging pages 15-16, paragraph bridging pages 23-24, paragraph bridging pages 25-26, page 29, lines 3-21, and Figure 6 flow chart). Throughout the text, the parent application demonstrates interactively drilling down through anatomical features displayed on a user interface. Therefore, the Examiner respectfully disagrees with Applicants’ interpretation of the teachings of the Lewis parent application, and interprets the Lewis reference to show teachings where applied. In addition, Examiner notes that it is the teachings of the combined, applied art, Lewis and Medigate, that must be considered when evaluating the 35 USC § 103 rejections.

As per Applicant's arguments on the paragraph bridging pages 9-10 of the response filed 14 October 2008 that "neither Lewis nor Yoder [Examiner interprets 'Yoder' to refer to the Medigate reference] discloses a tri-state control," Examiner respectfully disagrees. Examiner interprets Medigate's teachings of allowing the physician to utilize the letter "N" to designate "Normal" and "P" to denote problem areas and "X" to designate a positive affirmation that all the findings were checked (Medigate; pages 330, paragraph 2 to page 332, paragraph 1) to teach a form of a "tri-state control," and Examiner interprets Medigate's teachings of a "dynamic interactive user interface ... [with] ... menus that allow multiple ways of giving the same command ... [and] ... an interface where the user can give most commands at virtually any time ... [and with] ... an elaborate graphical interface that is adaptable to the users' needs (Medigate; page 328, paragraph 1) to teach a form of "selecting the tri-state control twice."

### ***Conclusion***

7. **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any response to this action should be mailed to:

**Commissioner of Patents and Trademarks**



**Washington D.C. 20231**

or faxed to: **(571) 273-8300.**

For formal communications, please mark "EXPEDITED PROCEDURE".

For informal or draft communications, please label  
"PROPOSED" or "DRAFT" on the front page of the  
communication and do NOT sign the communication.

After Final communications should be labeled "Box AF."

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Natalie A. Pass whose telephone number is (571) 272-6774. The examiner can normally be reached on Monday through Thursday from 9:00 AM to 6:30 PM. The examiner can also be reached on alternate Fridays.

10. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry O'Connor can be reached on (571) 272-6787. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

11. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you

would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or (571) 272-1000.

/N. A. P./

Examiner, Art Unit 3686

December 30, 2008

/Gerald J. O'Connor/  
Supervisory Patent Examiner  
Group Art Unit 3686